

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hixon et al.

Serial No.: 10/718,852

Filed: November 20, 2003

For: DIE CUTTING SYSTEM,
COMPONENTS THEREOF, AND
METHODS

Confirmation No.: 1905

Examiner: S. Choi

Group Art Unit: 3724

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REPLY BRIEF

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
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Attn: Board of Patent Appeals and Interferences

Sirs:

This Reply Brief is being filed pursuant to 37 C.F.R. § 41.41.

(7) ARGUMENT

A. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The 35 U.S.C. § 112, second paragraph, rejections of claims 64-68 and 70 have been fully addressed in the Appeal Brief and, therefore, require no further discussion.

B. REJECTIONS UNDER 35 U.S.C. § 102(b)

3. ANALYSIS

a. GASPARI

The dies to which claims 48, 61, 62, 68, 75, and 77 include “substantially planar” plates.

The term “substantially” has been used because the plates of the claimed dies have some thickness and, therefore, are not themselves planar. *See Examiner’s Answer*, pages 6-7. Nonetheless, the phrase “substantially planar” is intended to signify that the plate portion of each claimed die is very thin, as opposed to the relatively large, 0.17 inch thickness of the die plate that has been disclosed in Gaspari. Col. 4, lines 17-21. The as-filed specification, at paragraph [0037], even provides a non-limiting example of a 0.010 inch plate thickness that could be considered to be “substantially planar.” Notably, the thickness of the plate described in paragraph [0037] one-seventeenth of the thickness of the plate described in Gaspari.

Moreover, when the thickness of the die that has been described in Gaspari is considered in conjunction with the other dimensions of such a die (*see, e.g.*, FIG. 1 of Gaspari, in which each side edge appears to have a length of about an inch or two), the plates of the dies of Gaspari could hardly be considered to have a thickness that even comes close to approaching the “substantially planar” requirement of independent claims 48 and 62.

Thus, it should be apparent that Gaspari does not expressly or inherently describe a die with a “substantially planar plate,” as would be required for Gaspari to anticipate each and every element of independent claim 48, independent claim 62, and each of their dependent claims.

b. SABIN

It is apparent from the die 30 shown in Figs. 1 and 4 of Sabin, which appear to have dimensions similar to those of the dies of Gaspari, as well as from the description provided at col. 3, lines 40-45, that the dies described in Sabin also include plates that are very thick when compared with the “substantially planar” plates of the dies of independent claims 48 and 62.

Therefore, Sabin provides no express or inherent description of a die with a “substantially planar plate,” as would be required for Gaspari to anticipate each and every element of independent claim 48, independent claim 62, and each of their dependent claims.

c. EHLSCHEID

While the die of Ehlscheid includes a very thin plate, there is nothing planar or even “substantially planar” about its shape, as the description of Ehlscheid is limited to dies that are curved and include opposite edges with bent retention features. FIG. 2; col. 3, lines 38-44; col. 4, lines 13-21. Therefore, the dies that are described in Ehlscheid do not meet the “substantially planar plate” requirement of independent claims 48 and 62.

In addition, it is respectfully noted that Ehlscheid does not expressly or inherently describe a die with a plate that is “substantially rigid,” as required by independent claim 48, or

that has “a thickness to maintain its substantial planarity when not supported by said substantially planar die supporting surface...,” as required by independent claim 62.

Furthermore, with respect to the subject matter recited in independent claim 62, the description of Ehlscheid is limited to dies that are configured for use with industrial presses. It is respectfully submitted that Ehlscheid does not expressly or inherently describe a die with “a back side configured to be supported by a substantially planar die supporting surface of *a portable press.*” (Emphasis supplied).

C. REJECTIONS UNDER 35 U.S.C. § 103(a)

In addressing the reasoning that has been presented against the 35 U.S.C. § 103(a) rejections of claims 71-74, the Examiner has opined that “80 of Ehlscheid’s die could weigh less than a pound depending of peripheral dimensions.” Examiner’s Answer, page 9. The Examiner has unfortunately overlooked several important points.

First, the Examiner has apparently failed to consider that the teachings of Gaspari and Ehlscheid relate to Gaspari relate to dies that are configured for use with large presses that form large stencils. The stencils are to be used in sandblasting characters and other indicia into stone. Gaspari, col. 1, lines 14-47. The dies of Ehlscheid are, in contrast, configured for use with industrial rotary presses for cutting windows into paper products, such as in the manufacture of envelopes. Ehlscheid, col. 1, lines 5-8.

Second, because the teachings of both Gaspari and Ehlscheid are limited to dies that are configured for use with large presses, there would have been no apparent reason for one of

ordinary skill in the art to modify their dimensions in such a way as to make them useful with a portable press, as is required of the dies of claims 71-74.

Third, the Examiner has apparently disregarded the fact that Gaspari, at several locations (*see, e.g.*, col. 1, lines 48-51; col. 1, lines 56-58), expressly teaches away from the use of metal dies. The teachings of Ehlscheid are, however, limited to metal dies.

Therefore, without the benefit of hindsight that the Examiner has enjoyed throughout prosecution of the above-referenced application, there would have been no apparent reason for one of ordinary skill in the art to combine teachings from Gaspari and Ehlscheid in the manner that has been asserted.

D. COMMENTS FROM CONFEREES

The Examiner also asserts that the pending claims would read on “commonly known items such as, [sic] credit cards, bottle caps, or sole [sic] of a shoe.” Notably, none of these commonly known items includes a “substantially planar plate” or a “cutting edge” protruding from a surface of a substantially planar plate, as required by both independent claim 48 and independent claim 62 of the ‘852 Application.

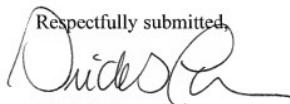
(11) CONCLUSION

It is respectfully submitted that:

(A) The rejections of claims 64-68 and 70 under 35 U.S.C. § 112, second paragraph, for various informalities will be addressed at a later date;

- (B) Claims 48, 61, 62, 68, 75, and 77 are allowable under 35 U.S.C. § 102(b) for being drawn to subject matter that is not anticipated by the subject matter described in Gaspari;
- (C) Claims 48, 61-67, and 77 are allowable under 35 U.S.C. § 102(b) for reciting subject matter that is patentable over the subject matter disclosed in Sabin;
- (D) Claims 48, 61, 62, 68-70, 75, and 76 recite subject matter that, under 35 U.S.C. § 102(b), is allowable over the subject matter described in Ehlscheid; and
- (E) Claims 71-74 are each allowable under 35 U.S.C. § 103(a) for being drawn to subject matter that is patentable over the teachings of both Gaspari and Ehlscheid.

Accordingly, reversal of the rejections of claims 48, 61-68, and 70-77 is respectfully solicited, as is an indication that each of these claims is allowable.

Respectfully submitted,


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